**CERTIFICATE OF MAILING**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Loriann Kazmercyk
Type or print name

Loriann Kazmercyk
Signature

January 9, 2006
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF
Section 1.01 FIONA MCPHEE, ET AL
APPLICATION NO: **10/825693**
FILED: **04/16/2004**
FOR: **MACROCYCLIC ISOQUINOLINE PEPTIDE INHIBITORS OF HEPATITIS C VIRUS**

ART UNIT: **1654**
EXAMINER: **HEARD, THOMAS SWEENEY**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In the Office Action dated October 18, 2005, restriction to one of the following groups was required:

- I. Claims 1-34 are drawn to a plurality of composition, classified in class 514, subclass 9.
- II. Claims 35-46 are drawn to a method of treatment with the compound(s) of Group I, classified in class 514, subclass 9.
- III. Claims 47-56 are drawn to a method of enzymatically resolving enantiomeric forms of the compound(s) of Group I, classified in class 514, subclass 9.

As stated in the paragraph bridging pages 2 and 3 of the Office Action, the Examiner's position with respect to the inventions of Group I and Group II is:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case interferon can be used to treat HCV infections and does not require the instantly claimed invention.

However, the Examiner's assertion is unsupported by an example of how the process as claimed can be practiced with another materially different product. Indeed, the process of Group II i.e., methods of claims 35-46 specifically reference the compound of claim 1, i.e., the product of Group I. Whether or not interferon can be used to treat HCV infections is irrelevant since applicants' process claims recite the compound of claim 1. It is respectfully submitted that the U.S. Patent and Trademark Office has failed to meet its burden to support the restriction requirement. Hence, for the foregoing reason, the restriction requirement is traversed.

The restriction requirements with respect to Group I and Group II, and Group II and Group III are not traversed.

Notwithstanding the traverse of the restriction of Group I and Group II, applicants provisionally elect the invention of Group I, claims 1-34.

Further, applicants elect the species from the structure set forth on page 156, compound 28. Claims 1-14, 17, 24, 26 and 27-34 read on the elected species.


An early and favorable Office Action is courteously solicited.

A request for extension of time of two months is submitted herewith.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

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Patent Department
P.O. Box 4000
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Date: January 9 2006



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